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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte STEVEN SHRAGA

Appeal 2007-1749
Application 10/641,142
Technology Center 3700

Decided: March 28, 2008

Before TERRY J. OWENS, JENNIFER D. BAHR, and
DAVID B. WALKER, *Administrative Patent Judges*.

WALKER, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellant seeks our review under 35 U.S.C. § 134 of the Examiner's final rejection of claims 1-3 and 8-44. We have jurisdiction under 35 U.S.C. § 6(b) (2002). We affirm.

Appellant claims a lancet device preferably having an adjusting capability and a method of using a lancet device (Specification 1:[0001]). Claim 1, reproduced below, is representative of the subject matter on appeal.

1. A lancet device, comprising:
 - a body;
 - a trigger;
 - a front cover comprising a skin engaging end that includes a lancet opening through which a lancet needle may extend;
 - a holding member movably mounted within the body and comprising a front end and a rear end;
 - a main spring disposed between the front and rear ends of the holding member;
 - the front end being configured to receive a lancet;
 - a first stop surface that moves with the holding member;
 - a second stop surface non-movably coupled to the body; and
 - the second stop surface extending inwardly from the body and being arranged between the first stop surface and the skin engaging end,

wherein at least partial rotation of the front cover causes the skin engaging end to move axially relative to the second stop surface.

THE REJECTIONS

The Examiner relies upon the following as evidence in support of the rejections:

Slama	US 4,469,110	Sep. 4, 1984
Schrage	US 6,156,051	Dec. 5, 2000

The following rejections are before us for review.

1. Claims 1-3, 8-23, 27-31, and 36-42 are rejected under 35 U.S.C. § 102(b) as anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as unpatentable over Schrage.
2. Claims 24-26 and 32-35 are rejected under 35 U.S.C. § 103(a) as unpatentable over Schrage.
3. Claims 43 and 44 are rejected under 35 U.S.C. § 103(a) as unpatentable over Slama.

ISSUE

The issue before us is whether Appellant has shown that the Examiner erred in rejecting: 1) claims 1-3, 8-23, 27-31, and 36-42 under 35 U.S.C. § 102(b) as anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as unpatentable over Schrage; 2) claims 24-26 and 32-35 under 35 U.S.C. § 103(a) as unpatentable over

Schrage; and 3) claims 43 and 44 are rejected under 35 U.S.C. § 103(a) as unpatentable over Slama. The dispositive issue is whether the cited prior art teaches a lancet device wherein at least partial rotation of the front cover causes the skin engaging end to move axially relative to the second stop surface.

Rather than repeat the arguments of Appellant and the Examiner, we make reference to the Briefs and the Answer for their respective details. Only those arguments actually made by Appellant have been considered in this decision. Arguments which Appellant could have made but chose not to make in the Briefs have not been considered and are deemed to be waived. *See* 37 C.F.R. § 41.37(c)(1)(vii) (2004).

FINDINGS OF FACT

We find the following enumerated findings to be supported by at least a preponderance of the evidence. *Ethicon, Inc. v. Quigg*, 849 F.2d 1422, 1427 (Fed. Cir. 1988) (explaining the general evidentiary standard for proceedings before the Office).

1. Schrage discloses a lancet device with a trigger similar to those shown in the embodiments of Figures 1-7 for use with the embodiment of Figure 16. Figure 16 shows a body (middle housing 20C), a holding member 30, a main spring 40 disposed between the front and rear ends of the holding member, a first stop surface (flange 176) that moves with the holding member, a second stop surface (guide collar 174) non-movably

coupled to the body and extending inwardly from the body and being arranged between the first stop surface and the skin engaging end (Schrage, col. 14, ll. 52-59; Fig. 16).

2. Schrage also teaches a cap segment 50 will be removably fitted on the housing 20 preferably through corresponding proportioning of an interior dimension of the open first side 51 of the cap segment 50 relative to the open second end 24 of the housing 20, but alternatively engagement ridges or a similar removable fastener system may be included to secure the cap segment 50 on the housing 20. Other removable fastener systems include threads, locking clips, and locking buttons (Schrage, col. 10, ll. 18-26).
3. One of skill in the art would have understood that removably fastening cover 50 to part 20A (shown in Figure 16) would cause part 20A to rotate with cover 50 if the cover 50 is rotated, causing parts 20A and 50 in combination to act as a cover as required by claim 1. Because part 20A is threadedly connected to body 20C via threads 170 and 172 (Schrage, Figure 16), one of skill in the art would have recognized that at least partial rotation of the front cover would cause the skin engaging end of cover 50 to move axially relative to the second stop surface.
4. Schrage explicitly teaches that although the cap segment is shown in Figure 8 as being triangular, it may be other shapes depending on the shape of the housing (Schrage, col. 10, ll. 3-12).

5. Schraga further teaches that indicia can be included on members that change position relative to each other when the penetration depth is adjusted in order to assist in determining the penetration depth of the insert (Schraga, col. 16, ll. 46-59).
6. Schraga further teaches a back cap configured to move the holding member to a retracted position and a second spring disposed between the rear end of the holding member and a surface of the back cap (Schraga, col. 14, ll. 52-59; Fig. 16).
7. Slama teaches a lancet device with a cover (labeled body 2) with an opening 8 through which the pin 1 is to project. The cover includes a threaded sleeve that permits the pin to advance relative to the body. The point of pin 1 can penetrate more or less deeply into the skin according to the degree of screwing the sleeve 10 into the cover. Each user can set the desired depth of penetration according to his skin and his preference. For facilitating the adjustment, a graduation scale 10a has been provided on the sleeve 10 and a mark 2b on the cover (Slama, col. 3, ll. 50-64).

PRINCIPLES OF LAW

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987), *cert. denied*, 484 U.S. 827 (1987).

“Section 103 forbids issuance of a patent when ‘the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.’” *KSR Int’l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1734 (2007). The question of obviousness is resolved on the basis of underlying factual determinations including (1) the scope and content of the prior art, (2) any differences between the claimed subject matter and the prior art, (3) the level of ordinary skill in the art, and (4) where in evidence, so-called secondary considerations. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966). *See also KSR*, 127 S.Ct. at 1734 (“While the sequence of these questions might be reordered in any particular case, the [*Graham*] factors continue to define the inquiry that controls.”)

In rejecting claims under 35 U.S.C. § 103(a), the examiner bears the initial burden of establishing a prima facie case of obviousness. *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992). *See also In re Piasecki*, 745 F.2d 1468, 1472 (Fed. Cir. 1984). Only if this initial burden is met does the burden of coming forward with evidence or argument shift to the appellant. *Id.* at 1445. *See also Piasecki*, 745 F.2d at 1472. Obviousness is then determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. *See Oetiker*, 977 F.2d at 1445; *Piasecki*, 745 F.2d at 1472.

ANALYSIS

A. Rejection of claims 1-3, 8-23, 27-31, and 36-42 under 35 U.S.C. § 102(b) as anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as unpatentable over Schraga.

Appellant advances several arguments for why claim 1 is neither anticipated by nor obvious over Schraga; all of which are predicated on the Appellant's interpretation that part 20A of Schraga is the body of the lancet device as defined in claim 1. Appellant provides no support for his insistence that 20A, and not 20C, is the body, except for a conclusory statement that Schraga clearly shows a front cover 50 and a body 20/20A (Reply Br. 2). We disagree.

For example, Appellant argues that the Examiner is incorrect that member 174 is non-movably coupled to the body 20A (Br. 7-8). The Examiner's rejection, however, found that 20C is analogous to the body as required by claim 1 and that member 174 is a second stop surface that is nonmovably coupled to the body 20C (Answer 3). We find the Examiner's reading of Schraga to be reasonable (Findings of Fact 1-3). Because Schraga meets the disputed claim limitation under the Examiner's reasonable interpretation, we find the Appellant's argument not to be persuasive.

Appellant further argues that cover 50 has a triangular cross section and slides onto a triangular portion of the body 20, and thus cannot possibly rotate relative to the body 20A (Br. 8). Appellant's argument is not persuasive because the Examiner's rejection in fact relies on the fact that cover 50 does not rotate

relative to part 20A, but rather in combination forms a cover. The Examiner found that the combination of parts 20A and 50 forms a cover as required by claim 1 and at least partial rotation of the front cover 20A, 50 causes the skin engaging end (at the distal end of 50) to move axially relative to the second stop surface due to the threaded connection at 170, 172 (Answer 4 citing Schraga, col. 14, ll. 21-24). We agree with the Examiner that Schraga teaches all of the limitations of and therefore anticipates claim 1 (Findings of Fact 1-3). Appellant has not shown error in the Examiner's rejection of claim 1. Claims 2-3, 8-16, 18-23, 27-29, 31, 36-38, and 41 were not argued separately, and fall with claim 1. *See* 37 C.F.R. § 41.37(c)(1)(vii). *See also In re Young*, 927 F.2d 588, 590 (Fed. Cir. 1991).

With respect to claim 17, Appellant separately argues that Schraga fails to disclose any penetration depth adjustment between the front cover 50 and body 20 (Br. 9). Similar to the arguments advanced against the rejections of claim 1, this argument depends on the Appellant's erroneous interpretation of Schraga. Under the Examiner's interpretation of the parts of Schraga, the threaded connection between parts 20A and 20C provides a mechanism for temporarily maintaining a depth setting position of the cover as required by claim 17 (Finding of Fact 3). Appellant has not shown error in the Examiner's rejection of claim 17.

With respect to claim 30, the Appellant argues that Schraga discloses a triangular front cover 50 that slides onto the body 20 and that does not rotate relative to the body 20 (Br. 10). As discussed in reference to claim 1, Figure 16 of Schraga shows that part 20A (which acts in combination with cover 50 as a cover)

rotates about an axis that runs through the lancet opening and the holding member via threads 170 and 172 (Finding of Fact 3). The Appellant has not shown error in the Examiner's rejection of claim 30.

With respect to claim 39, Appellant relies on the same position that the cover doesn't rotate argued with respect to the above rejections, and thus argues the front cover lacks the gripping projections required by claim 39. The Examiner found that Schraga discloses gripping protrusions at the corners of the triangular shaped front cover 20A, 50. We agree with the Examiner that the corners of a triangular shaped cover can serve as gripping protrusions as required by claim 39. The Appellant has not shown error in the Examiner's rejection of claim 39.

With respect to claim 40, Appellant argues that Schraga does not teach threads connecting the front cover to the body. This argument depends on the Appellant's erroneous interpretation of Schraga asserted with respect to claim 1. Because the cover 20A, 50 is connected to body 20C by threads 170, 172, Appellant has not shown error in the Examiner's rejection of claim 40.

The Appellant similarly argues that the Examiner's rejection of claim 42 is improper because Schraga does not teach rotating the front cover to a desired position. Because the cover 20A, 50 rotates relative to body 20C via threads 170, 172, Appellant has not shown error in the Examiner's rejection of claim 42.

B. Rejection of claims 24-26 and 32-35 under 35 U.S.C. § 103(a) as unpatentable over Schraga.

Appellant argues only claim 26. The Appellant restates the arguments found to be unpersuasive with respect to the above rejections over Schraga. Those arguments are equally unpersuasive as to this rejection. The Appellant further argues that it would not make sense to arrange indicia on an outer circumferential surface of the cover because: 1) the front cover 50 is disclosed as triangular and thus lacks an outer circumferential surface; and 2) the front cover does not participate in penetration depth adjustment. We find this argument unpersuasive because the triangular cover shape is only one of several configurations taught by Schraga (Finding of Fact 4), and the front cover as construed by the Examiner does participate in penetration depth adjustment. Moreover, Schraga further teaches that indicia can be included on members that change position relative to each other when the penetration depth is adjusted in order to assist in determining the penetration depth of the insert (Finding of Fact 5). The Appellant has failed to show error in the Examiner's rejection of claim 26. Claims 24-25 and 32-35 were not argued separately, and fall with claim 26. *See* 37 C.F.R. § 41.37(c)(1)(vii). *See also Young*, 927 F.2d at 590 (Fed. Cir. 1991).

C. Rejection of claims 43 and 44 under 35 U.S.C. § 103(a) as unpatentable over Slama.

Appellant argues that no proper combination of the cited references discloses or suggests a main spring disposed between the front and rear ends of the holding member and a second stop surface axially retained to a front portion of the body, as recited in independent claim 43 (Br. 15). We find this argument unpersuasive because these features are taught by Schraga (Finding of Fact 1).

Appellant argues that no proper combination of the cited references discloses or suggests a back cap configured to move the holding member to a retracted position, a second spring disposed between the rear end of the holding member and a surface of the back cap, and a second stop surface axially retained to a front portion of the body, as recited in independent claim 44 (Br. 18). We find this argument unpersuasive because these features are taught by Schraga (Findings of Fact 1 & 6). The Appellant has failed to show error in the Examiner's rejection of claims 43 and 44.

CONCLUSIONS

We conclude that Appellant has not shown that the Examiner erred in rejecting claims 1-3, 8-23, 27-31, and 36-42 under 35 U.S.C. § 102(b) as anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as unpatentable over Schraga. We conclude that Appellant has not shown that the Examiner erred in

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rejecting claims 24-26 and 32-35 under 35 U.S.C. § 103(a) as unpatentable over Schraga. We conclude that Appellant has not shown that the Examiner erred in rejecting claims 43 and 44 under 35 U.S.C. § 103(a) as unpatentable over Slama.

DECISION

The decision of the Examiner to reject claims 1-3 and 8-44 is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv) (2006).

AFFIRMED

jlb

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